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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/720,512	11/24/2003	Anthony G. Karandinos	1999B060 / 3	5158

23455 7590 02/28/2007
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EXAMINER

RABAGO, ROBERTO

ART UNIT	PAPER NUMBER
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1713

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/28/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

10/720,512

Applicant(s)

KARANDINOS ET AL.

Examiner

Roberto Rábago

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14-16 and 41-58 is/are pending in the application.
- 4a) Of the above claim(s) 41-50 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14-16 and 51-58 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application
- ☐ Other: _____

DETAILED ACTION

1. Prior rejection under 35 USC 112 as set forth in item 2(a) of the Office action mailed 6/30/2006 is withdrawn. Applicants' remarks, in combination with the declaration of Jean Tancrede filed 12/4/2006, sufficiently establish the meaning of MFR as stated in the specification and claims to require a load condition of 2.16 kg. As previously stated, the specification provides basis to require that the MI as stated in the specification and claims also requires a 2.16 kg load. The claims are therefore examined under the requirements of MI_{190/2.16} and MFR_{230/2.16}.

Claim Rejections - 35 USC § 112

2. Claims 14-16 and 51-58 are rejected under 35 U.S.C. 112, first paragraph, as based on a disclosure which is not enabling. An additional processing step wherein the MFR is dramatically increased, critical or essential to the practice of the invention, but not included in the claim(s) is not enabled by the disclosure. See *In re Mayhew*, 527 F.2d 1229, 188 USPQ 356 (CCPA 1976). By applicants' remarks and declaration filed 12/4/2006, the MFR has been limited to requiring a load of 2.16 kg. The specification has been reviewed, but no disclosure can be found for producing an adhesive composition comprising a copolymer wherein the polymerization method recited in the claims produces the claimed MFR_{230/2.16}. For polymers with MFR_{230/2.16} >250 dg/min, the specification appears to provide disclosure only for a process which includes a subsequent step of contact with a free radical initiator (see pg. 29, line 10 through page

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30, line 10; pg. 34, paragraph 1). Because the specification does not provide support for any other method of obtaining the required product, the claims are not enabled because at least one essential method step is missing.

The claims were not previously rejected on these grounds because the claims had not defined the MFR load condition, and were therefore open to a variety of other higher loads which could reasonably have produced the claimed MFR.

3. Claims 14-16 and 51-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. By applicants' remarks and declaration filed 12/4/2006, the MFR has been limited to requiring a load of 2.16 kg. The specification has been reviewed, but no enabling disclosure can be found for a method of making an adhesive comprising a copolymer wherein the $MI_{190/2.16}$ may be as low as 7 dg/min, yet simultaneously the $MFR_{230/2.16} > 250$ dg/min. The embodiments disclosing a copolymer with $MI_{190/2.16}$ as low as 7 dg/min appear to be directed only to the unmodified copolymer, whereas the material with $MFR_{230/2.16} > 250$ dg/min appears to be directed only to the copolymer following contact with a free radical initiator.

The claims were not previously rejected on these grounds because the claims had not defined the MFR load condition, and were therefore open to a variety of other higher loads which could reasonably have produced the claimed MFR.

4. Claims 14-16 and 51-58 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. By applicants' remarks and declaration filed 12/4/2006, the MFR has been limited to requiring a load of 2.16 kg. In view of this narrowing of the claimed scope, support for the following claimed embodiments cannot be found in the specification as filed.

(a) In claims 15, 54 and 55, no disclosure can be found in the specification as filed for a process of step (c) wherein a second polymerization is performed and combined with a polymer having $MFR_{230/2.16} > 250$.

(b) In claims 14-16 and 51-58, no disclosure can be found in the specification as filed for a copolymer which simultaneously has $MI_{190/2.16}$ as low as 7 dg/min and $MFR_{230/2.16} > 250$ dg/min.

Claim Rejections - 35 USC § 102

5. Claims 14, 16, 52, 56 and 58 are rejected under 35 U.S.C. 102(e) as being anticipated by Agarwal et al. (US 6,407,171).

The reference discloses the making of metallocene polypropylene copolymer having $MFR_{230/2.16} > 500$ dg/min, comonomer content less than 12% or less than 20%, and having substantial crystallinity due to isotactic and/or syndiotactic sequences (see

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abstract; summary of the invention; col. 5, lines 33 through col. 6, line 2; claims 6-7).

The reference has not reported $MI_{190/2.16}$, % pentad isotactic or syndiotactic sequences, or adhesiveness; however, these properties would be inherent for the following reasons.

A polymer which has $MFR_{230/2.16} > 500$ dg/min would inherently be expected to have $MI_{190/2.16}$ of some value within the range of 500-3000 dg/min; one of ordinary skill in the art would immediately envisage embodiments of at least 40% isotactic or syndiotactic pentads because the reference has specifically recommended that the polypropylene-based polymer have crystallinity derived from isotactic or syndiotactic sequences to be as high as 85%; finally, the high molecular weight polymer described in the reference would necessarily have at least non-zero adhesiveness, meeting the limitation that the material be an adhesive. The burden of proof is shifted to applicants to show that the recommended reference polymers would not have all claimed properties.

6. Applicant's response necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any

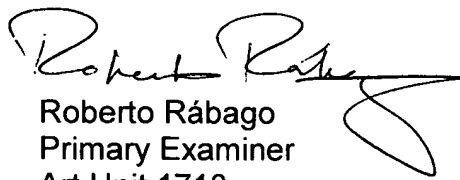
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extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roberto Rábago whose telephone number is (571) 272-1109. The examiner can normally be reached on Monday - Friday from 8:00 - 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Roberto Rábago
Primary Examiner
Art Unit 1713

RR
February 18, 2007